



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/613,533	07/10/2000	Keiichi Uno	1968.4	9684

5514 7590 05/10/2004

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

NAJJAR, SALEH

ART UNIT	PAPER NUMBER
----------	--------------

2157

DATE MAILED: 05/10/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

SL

Office Action Summary

Application No.

09/613,533

Applicant(s)

UNO ET AL.

Examiner

Saleh Najjar

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27, 34-73, 88-127 and 142-158 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 28-33, 74-87 and 128-141 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4, 6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO)
- 6) ☐ Other: _____.

1. This action is responsive to the response to election/restriction filed February 13, 2004. Group I claims 1-27, 34-73, 88-127, and 142-158 was elected with traverse. Applicant is requested to cancel Group II claims 28-33, 74-87, and 128-141.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-21, 23-24, 27, 35-45, 47-48, 50-67, 69-84, 86-99, 101-121, 123-124, 126, 142-153, 155-156, and 158 are rejected under 35 U.S.C. 102(b) as being anticipated by Lamming et al., U.S. Patent No. 5,862,321.

Lamming teaches the invention as claimed including a system and method for accessing and distributing electronic documents (see abstract).

As to claim 1, Lamming teaches a data storing and reproducing system using a computer network comprising:

server comprising means for storing reproduction data (see fig. 1; col. 3-5, server 12);

at least one attachment unit coupled to the server, the at least one attachment unit comprising means for interfacing with a portable memory device having a reference to the reproduction data (see fig. 1; col. 6-9, pda 16);

first and second reproduction devices coupled to one or more of the at least one attachment unit, the first reproduction device capable of performing a first reproduction of the reproduction data and the second reproduction device capable of performing a second reproduction of the reproduction data, the second data reproduction being different than the first data reproduction (see figs. 1-7; col. 5-10, Lamming discloses that the reproduction devices comprise a printer, Facsimile of a multifunction fax);

wherein the server responds to a request from the at least one attachment unit by transmitting the reproduction data and where the reproduction data is determined to

be a format unsuitable for the reproduction device, the data is reformatted for use by the reproduction device (see col. 4, lines 1-14, Lamming discloses that the server is responsible for converting the document in a format appropriate to the reproduction device).

As to claim 2, Lamming teaches the data storing and reproducing system according to Claim 1, wherein the at least one attachment unit is internal to the first reproduction device (see col. 9, lines 50-65).

As to claim 3, Lamming teaches the data storing and reproducing system according to Claim 1, wherein the first and second reproduction devices further comprise means for sending data to the server (see col. 9-10).

As to claim 4, Lamming teaches the data storing and reproducing system according to Claim 3, wherein the at least one attachment unit further comprises means for receiving information corresponding to the sent data for storage in the portable memory device (see fig. 1; col. 3-6, para 16).

As to claim 5, Lamming teaches the data storing and reproducing system according to Claim 4, wherein all or a portion of the information is received from the server (see col. 3-9).

As to claim 6, Lamming teaches the data storing and reproduction system according to Claim 1, wherein the portable memory device is usable with multiple attachment units and reproduction devices (see col. 4-10).

As to claim 7, Lamming teaches the data storing and reproducing system according to Claim 1, wherein the at least one attachment unit further comprises a user interface for outputting information and receiving instructions (see col. 4-10).

As to claim 8, Lamming teaches the data storing and reproducing system according to Claim 7, wherein the user interface comprises a portion that is common to all reproduction devices and another portion that is customized to an attached reproduction device (see col. 4-10).

As to claim 9, Lamming teaches the data storing and reproducing system

according to Claim 8, wherein the customizable portion of the user interface is generated based on function information received from the attached data reproduction device (see col. 4-10).

As to claim 10, Lamming teaches the data storing and reproducing system according to Claim 7, wherein the user interface displays for selection at least one entry corresponding to a data reference stored in the portable memory device and at least one selectable function associated of a reproduction device (see col. 8-11).

As to claim 11, Lamming teaches the data storing and reproducing system according to Claim 1, wherein the server further comprises:

means for determining whether to convert the data into a format suitable for a reproduction device; and means for converting the data to such a format based on the determination by the determining means (se fig. 1; col. 4, lines 1-20).

As to claim 12, Lamming teaches the data storing and reproducing system according to Claim 11, wherein the suitable format for the identified reproduction device is image data format and the data is not image data, the conversion means causing the data to be converted to image data (see col. 7-11).

As to claim 13, Lamming teaches the data storing and reproducing system according to Claim 12, wherein the image data is in the form of Hypertext Markup Language (HTML) image data (see col. 4-6).

As to claim 14, Lamming teaches the data storing and reproducing system according to Claim 1, wherein the attachment unit further comprises:

means for generating a conversion request directed to the server, the conversion request based on information stored in the portable memory device received from the attachment unit (see col. 5-11).

As to claim 15, Lamming teaches the data storing and reproducing system according to Claim 14, wherein the generation means further comprising:

means for determining whether or not the data is of a format that is suitable for the reproduction device; means for sending a conversion request to the server based on the determination by the determining means (see col. 5-11).

As to claim 16, Lamming teaches the data storing and reproducing system

Art Unit: 2157

according to Claim 15, wherein the sending means further comprises:

means for determining whether the attachment unit is capable of converting the data; and means for sending a conversion request when it is determined that the attachment unit is not capable of converting the data (see col. 5-11).

As to claim 17, Lamming teaches the data storing and reproducing system according to Claim 1, wherein the portable memory device stores information received from the server (see col. 4-6).

As to claim 18, Lamming teaches the data storing and reproducing system according to Claim 17, wherein the stored information includes personal information unique to a user of the portable memory device (see col. 4-6).

As to claim 19, Lamming teaches the data storing and reproducing system according to Claim 17, wherein the stored information includes a file reference corresponding to each data file sent to the server using the portable memory device (see col. 4-6).

As to claim 20, Lamming teaches the data storing and reproducing system according to Claim 17, wherein the stored information includes a format attribute identifying a format of a data file sent to the server using the portable memory device (see col. 4-8).

As to claim 21, Lamming teaches the data storing and reproducing system according to Claim 17, wherein the stored information includes personal facsimile information used in sending the data as a facsimile message (see col. 4-8).

As to claim 23, Lamming teaches the data storing and reproducing system according to Claim 1, wherein the first or second reproduction device is a computer (see col. 4-8).

As to claim 24, Lamming teaches the data storing and reproducing system according to Claim 1, wherein the first or second reproduction device is one of a print, copier, facsimile and display devices (see col. 4-8).

As to claim 27, Lamming teaches the data storing and reproducing system according to Claim 1, wherein the at least one attachment unit further comprises means

Art Unit: 2157

for sending a delete request to cause an entry to be deleted from the portable memory device and the corresponding data stored on the server to be deleted (see col. 4-8).

Claims 35-45, 47-48, 50-67, 69-84, 86-99, 101-121, 123-124, 126-127, 142-153, 155-156, and 158 do not teach or define any new limitations above claims 1-21, 23-24, 27 and therefore are rejected for similar reasons.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 22, 25-26, 46, 49, 68, 85, 100, 122, 125, 154, and 157 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lamming et al., U.S. Patent No. 5,862,321 further in view of Eldridge et al., U.S. Patent No. 6,397,261.

Lamming teaches the invention substantially as claimed including a system and method for accessing and distributing electronic documents (see abstract).

As to claim 22, Lamming teaches the data storing and reproducing system according to Claim 17.

Lamming does not explicitly teach the claimed limitation wherein the stored information includes email information used in sending the data as an email message.

However, Eldridge teaches a token based document transaction system for email clients (see abstract). Eldridge teaches wherein the stored information includes email information used in sending the data as an email message (see col. 4-8).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lamming by including the email transaction capabilities as taught by Eldridge. One would be motivated to do so to allow document distribution in an electronic mail environment.

Claims 25-26, 46, 49, 68, 85, 100, 122, 125, 154, and 157 do not teach or define any new limitations above claims 1-22 and therefore are rejected for similar reasons.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saleh Najjar whose telephone number is (703) 308-7613. The examiner can normally be reached on Monday-Friday from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Ario Etienne*, can be reached on (703) 308-7562. The fax phone number for this Group is (703) 308-9052.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600. The central official fax number for the group is (703) 872-9306.



Saleh Najjar

Primary Examiner / Art Unit 2157